

REMARKS

This is a full and timely response to the outstanding Notice of Non-Compliant Amendment mailed August 31, 2006. This response is submitted as a substitute for the Response mailed June 23, 2006. Upon entry of the amendments in this response claims 1-49 are pending. More specifically, claims 1, 2, 4-7, 10, 11, 21-23, 26-28, 38-47, and 49 are amended. These amendments are specifically described hereinafter.

I. Present Status of Patent Application

Claims 1-12, 15-29, 32-42, and 44-49 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by *Mertama, et al* (U.S. Patent No. 6,629,130). Claims 13-14, 30-31, and 43 are rejected under 35 U.S.C. as allegedly being unpatentable over *Mertama, et al* (U.S. Patent No. 6,629,130) in view of *Crispin* (RFC 1730: Internet Message Access Protocol-Version 4, December 1994). These rejections are respectfully traversed.

II. Examiner Interview

Applicant first wishes to express sincere appreciation for the time that Examiner Swearingen spent with Applicant's representative Benjie Balser during a May 9, 2006 telephone discussion regarding the above-identified Office Action. During the interview, various features described in the patent application and recited in the independent claims, including a destination address and *Crispin*, were discussed, and the outcome of this discussion is addressed herein. During that conversation, Examiner Swearingen seemed to indicate that it would be potentially beneficial for Applicant to file this response. Thus, Applicant respectfully requests that Examiner Swearingen carefully consider this response.

III. Rejections Under 35 U.S.C. §102(e)

A. Claims 1-12 and 15-22

The Office Action rejects claims 1-12 and 15-22 under 35 U.S.C. §102(e) as allegedly being anticipated by *Mertama, et al* (U.S. Patent No. 6,629,130). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 as amended recites:

1. A method for managing a predetermined set of email messages stored on a source email server from a remote email network, said method comprising the steps of:

- (a) *receiving an email at the source email server, wherein the email is separate from the predetermined set of emails stored on the source email server, wherein said email has a destination email address in a first field, a code in a second field and an instruction in a third field, wherein said destination email address corresponds to a subscriber account on the remote email network;*
- (b) checking a database to determine a permission for the destination email address; and
- (c) applying the instruction to the predetermined set of emails if the permission is granted.

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 as amended is allowable for at least the reason that *Mertama* does not disclose, teach, or suggest at least **receiving an email at the source email server, wherein the email is separate from the predetermined set of emails stored on the source email server, wherein said email has a destination email address in a first field, a code in a second field and an instruction in a third field, wherein said**

destination email address corresponds to a subscriber account on the remote email network. Even if, arguendo, *Mertama* discloses an IMAP message, it fails to disclose an email. IMAP is a protocol for managing emails; it is not an email. Therefore, *Mertama* does not anticipate independent claim 1, and the rejection should be withdrawn.

Because independent claim 1 as amended is allowable over the cited references of record, dependent claims 2-12 and 15-22 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-12 and 15-22 contain all the steps/features of independent claim 1. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2-12 and 15-22 are patentable over *Mertama*, the rejection to claims 2-12 and 15-22 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-12 and 15-22 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 2-12 and 15-22 are allowable.

B. Claims 23-29 and 32-37

The Office Action rejects claims 23-29 and 32-37 under 35 U.S.C. §102(e) as allegedly being anticipated by *Mertama, et al* (U.S. Patent No. 6,629,130). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 23 as amended recites:

23. A method for managing a predetermined set of emails previously stored on a source email server from a remote email network, said method comprising the steps of:

- (a) populating a database with subscriber email addresses corresponding to subscriber accounts authorized to remotely manage emails;

(b) *receiving an email at the source email server, the email not included in the predetermined set of emails previously stored on a source email server, wherein said email has a destination email address in a first field, a code in a second field and an instruction in a third field, wherein said destination email address corresponds to a subscriber account on the remote email network;*

(c) checking the database to determine a permission for the destination email address; and

(d) applying the instruction to the predetermined set of emails if the permission is granted.

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue.

Applicant respectfully submits that independent claim 23 as amended is allowable for at least the reason that *Mertama* does not disclose, teach, or suggest at least **receiving an email at the source email server, the email not included in the predetermined set of emails previously stored on a source email server, wherein said email has a destination email address in a first field, a code in a second field and an instruction in a third field, wherein said destination email address corresponds to a subscriber account on the remote email network**. Even if, arguendo, *Mertama* discloses an IMAP message, it fails to disclose an email. IMAP is a protocol for managing emails; it is not an email. Therefore, *Mertama* does not anticipate independent claim 23, and the rejection should be withdrawn.

Because independent claim 23 as amended is allowable over the cited references of record, dependent claims 24-29 and 32-37 (which depend from independent claim 23) are allowable as a matter of law for at least the reason that dependent claims 24-29 and 32-37 contain all the steps/features of independent claim 23. Therefore, since dependent claims 24-29 and 32-37 are patentable over *Mertama*, the rejection to claims 24-29 and 32-37 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 23, dependent claims 24-29 and 32-37 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 24-29 and 32-37 are allowable.

C. Claims 38-42

The Office Action rejects claims 38-42 under 35 U.S.C. §102(e) as allegedly being anticipated by *Mertama, et al* (U.S. Patent No. 6,629,130). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 38 as amended recites:

38. A method for remotely retrieving a first email from a source email server to a destination email address having a standard email client application, said method comprising the steps of:

- (a) populating a database with subscriber email addresses corresponding to subscriber accounts authorized to remotely retrieve emails;
- (b) ***receiving a second email on the source server, wherein said second email has the destination address in a sender field and a code in a predetermined field;***
- (c) checking the database to verify the destination email address as an authorized account; and
- (d) sending, in response to the code, the first email from the source email server to the destination email address.

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue.

Applicant respectfully submits that independent claim 38 as amended is allowable for at least the reason that *Mertama* does not disclose, teach, or suggest at least **receiving a second**

email on the source server, wherein said second email has the destination address in a sender field and a code in a predetermined field. Even if, *arguendo*, *Mertama* discloses an IMAP message, it fails to disclose an email. IMAP is a protocol for managing emails; it is not an email. Therefore, *Mertama* does not anticipate independent claim 38, and the rejection should be withdrawn.

Because independent claim 38 as amended is allowable over the cited references of record, dependent claims 39-42 (which depend from independent claim 38) are allowable as a matter of law for at least the reason that dependent claims 39-42 contain all the steps/features of independent claim 38. Therefore, since dependent claims 39-42 are patentable over *Mertama*, the rejection to claims 39-42 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 38, dependent claims 39-42 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 39-42 are allowable.

D. Claims 44-48

The Office Action rejects claims 44-48 under 35 U.S.C. §102(e) as allegedly being anticipated by *Mertama, et al* (U.S. Patent No. 6,629,130). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 44 as amended recites:

44. A method for remotely managing a first email on a source email server from an email account on a remote email server, said method comprising the steps of:

- (a) ***receiving a second email on the source server, wherein said second email has a code in a first predetermined field;***
- (b) checking a database for a subscriber account corresponding to a sender field in the second email; and
- (c) processing the first email according to an instruction in a second predetermined field.

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue.

Applicant respectfully submits that independent claim 44 as amended is allowable for at least the reason that *Mertama* does not disclose, teach, or suggest at least **receiving a second email on the source server, wherein said second email has a code in a first predetermined field**. Even if, arguendo, *Mertama* discloses an IMAP message, it fails to disclose an email. IMAP is a protocol for managing emails; it is not an email. Therefore, *Mertama* does not anticipate independent claim 44, and the rejection should be withdrawn.

Because independent claim 44 as amended is allowable over the cited references of record, dependent claims 45-48 (which depend from independent claim 44) are allowable as a matter of law for at least the reason that dependent claims 45-48 contain all the steps/features of independent claim 44. Therefore, since dependent claims 45-48 are patentable over *Mertama*, the rejection to claims 45-48 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 44, dependent claims 45-48 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 45-48 are allowable.

E. Claim 49

The Office Action rejects claim 49 under 35 U.S.C. §102(e) as allegedly being anticipated by *Mertama, et al* (U.S. Patent No. 6,629,130). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 49 as amended recites:

49. A system for managing a predetermined set of emails on a source email server from a remote email network, said system comprising:

(a) a registration database on the source server, said registration database comprising a local subscriber account on said source server and an associated destination email address on the remote email network;

(b) *a first module on the source email server, wherein when a first email having a code in a first field, the first email not included in the predetermined set of emails previously stored on a source email server, an instruction in a second field of the first email and a sender email address in a sender field is received on the source email server, said first module determines if the sender email address is in the database;* and

(c) a second module on the source server, wherein if the sender email address is in the database, the second module applies the instruction to the predetermined set of emails.

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue.

Applicant respectfully submits that independent claim 49 is allowable for at least the reason that *Mertama* does not disclose, teach, or suggest at least **a first module on the source email server, wherein when a first email having a code in a first field, the first email not included in the predetermined set of emails previously stored on a source email server, an instruction in a second field of the first email and a sender email address in a sender field is received on the source email server, said first module determines if the sender email address is in the database.** Even if, *arguendo*, *Mertama* discloses an IMAP message, it fails to disclose an email. IMAP is a protocol for managing emails; it is not an email. Therefore, *Mertama* does not anticipate independent claim 49, and the rejection should be withdrawn.

IV. Rejections Under 35 U.S.C. §103(a)

A. Claims 13-14

The Office Action rejects claims 13-14 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mertama, et al* (U.S. Patent No. 6,629,130) in view of *Crispin* (RFC 1730: Internet Message Access Protocol-Version 4, December 1994). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Because independent claim 1 is allowable over the cited references of record, dependent claims 13-14 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 13-14 contain all the steps/features of independent claim 1. Therefore, the rejection to claims 13-14 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 13-14 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 13-14 are allowable.

Additionally, with regard to the rejection of claims 13-14, *Crispin* does not make up for the deficiencies of *Mertama* noted above. Therefore, claims 13-14 are considered patentable over any combination of these documents.

B. Claims 30-31

The Office Action rejects claims 30-31 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mertama, et al* (U.S. Patent No. 6,629,130) in view of *Crispin* (RFC 1730: Internet Message Access Protocol-Version 4, December 1994). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Because independent claim 23 is allowable over the cited references of record, dependent claims 30-31 (which depend from independent claim 23) are allowable as a matter of law for at least the reason that dependent claims 30-31 contain all the steps/features of independent claim 23. Therefore, the rejection to claims 30-31 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 23, dependent claims 30-31 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 30-31 are allowable.

Additionally, with regard to the rejection of claims 30-31, *Crispin* does not make up for the deficiencies of *Mertama* noted above. Therefore, claims 30-31 are considered patentable over any combination of these documents.

C. Claim 43

The Office Action rejects claim 43 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mertama, et al* (U.S. Patent No. 6,629,130) in view of *Crispin* (RFC 1730: Internet Message Access Protocol-Version 4, December 1994). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Because independent claim 38 is allowable over the cited references of record, dependent claim 43 (which depends from independent claim 38) is allowable as a matter of law for at least the reason that dependent claim 43 contains all the steps/features of independent claim 38. Therefore, the rejection to claim 43 should be withdrawn and the claim allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 38, dependent claim 43 recites further features and/or combinations of features, as are apparent by examination of the claim itself, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claim 43 is allowable.

Additionally, with regard to the rejection of claim 43, *Crispin* does not make up for the deficiencies of *Mertama* noted above. Therefore, claim 43 is considered patentable over any combination of these documents.

V. Miscellaneous Issues

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-49 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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